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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Alic Anthony Scott

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12/04/2006

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/874,856	<b>Applicant(s)</b> SCOTT ET AL.	
	<b>Examiner</b> Gina C. Yu	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 6-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/1/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on April 1, 2006 has been entered.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on April 1, 2006 was filed before the mailing of a first Office action after the filing of a request for continued examination under § 1.114. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Objections***

Claim 7 is objected to because of the following informalities: In claim 7, lines 3-7, each of the terms "poyvinylacetate latexes", "styrene/butadiene copolymer latexes", "butadiene/acrylonitrile copolymer latexes" are repeatedly recited in the Markush group. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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**Claims 1-4 and 6-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholomey et al. (US 5614200) ("Bartholomey") in view of Snyder et al. (US 5389363) ("Snyder").**

Bartholomey teaches mascara compositions comprising lecithin (Phospholipon 80), which meets the limitations of instant claim 1(a) and 2-4; and ammonia acrylate copolymer (Syntran 5170) which meets the limitations of instant claims 1(c) and 6-8. See Examples; see also the disclosure of fractionated lecithin in col. 5, lines 31-48. Adding film-forming agents such as PVP and PVP/VA copolymers is suggested in col. 5, line 49 – 6. See instant claim 1(b). The example formulations in Bartholomey also use waxes, glyceryl monostearate, water/ethanol solvents, black iron oxide, triglyceride, and preservatives. See instant claims 9 and 12-25. The weight ratio of glycerol monostearate to lecithin as required by instant claims 10-11 are disclosed in col. 5, lines 11 – 30.

As for claim 24, the terms "foundations", "eyeliners", "lipliners", "eyeshadows", and "rouges" define the intended use of the claimed invention. Examiner views that these terms are directed to a composition in a dermatologically suitable carrier which contains decorative pigments and polymer(s) which enables the composition to adhere to a substrate. However, there are no further differences among the recited products, other than the intended future usage of these products, which would distinguish one composition from the other. Thus, these terms in the claims are given patentable weight to the extent that the structure of the composition is defined by the terms. See MPEP § 2111.02. Since the prior art mascara composition also contain pigments and polymers in a topically suitable carrier, the prior art meets the present claim limitations.

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Bartholomey fails teach the specific type of PVP copolymers in instant claim 1(b).

Snyder teaches a waterproof mascara formulations comprising 1.5 % of PVP/tricontanyl copolymer. See Examples 1 and 2. See also col. 4, line 55 – col. 5, line 8.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the composition of Bartholomey by substituting the film-forming polymers with PVP/tricontanyl copolymer, as motivated by Snyder, because 1) Bartholomey generally teaches using film-forming agents such as PVP copolymers in mascara formulation; 2) Snyder teaches that PVP/tricontanyl copolymer forms a waterproof film forming composition. The skilled artisan would have had a reasonable expectation of successfully producing a stable waterproof mascara formulation.

**Claims 1-3, 9, 12-14, 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannell et al. (US 6,221,389 B1) ("Cannell") in view of Snyder et al. (US 5389363) ("Snyder").**

Cannell teaches a mascara composition comprising 0.133 weight % of lecithin, 1 % of PVP/VA copolymer, 1.5 % PVP/eicosene copolymer, 4 % of polysaccharide resin, and 10 % of Avaluare ® resin solution in water. See Example 22; instant claims 1-3, 12-14, and 25. Water-insoluble latex is taught in col. 7, lines 61-66. See instant claim 6. Example 22 contains glyceryl monostearate, meeting instant claims 9 and 22. Beeswax, polyethylene (wax), and iron oxide are also used in the formulation. See instant claims 16-19. Since the reference teaches iron oxide, the color of the iron oxide would have been an obvious selection of a skilled artisan. See instant claim 20. Also employed in the formation of Example 22 is polymethyl methacrylate isopropyl titanium

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triisostearate, which is a treated titanium oxide pigment. See instant claim 21. The prior mascara composition also contains paraben preservatives, meeting instant claim 23.

With respect to claim 24, the terms "foundations", "eyeliners", "lipliners", "eyeshadows", and "rouges" are given patentable weight to the extent that the structure of the composition is defined by the terms. See above. Since the prior art mascara composition also contain pigments and polymers in a topically suitable carrier, the prior art meets the present claim limitations.

Cannell fails teach the specific type of PVP copolymers in instant claim 1(b).

Snyder teaches a waterproof mascara formulations comprising 1.5 % of PVP/tricontanyl copolymer. See Examples 1 and 2. See also col. 4, line 55 – col. 5, line 8.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the composition of Cannell by substituting the film-forming polymers with PVP/tricontanyl copolymer, as motivated by Snyder, because 1) Cannell teaches the PVP/eicosene copolymer in oil phase, which indicates that it is a water-insoluble, water-resistant film forming polymer; and 2) Snyder teaches that PVP/tricontanyl copolymer forms a water-proof film forming mascara composition. Since both PVP/tricontanyl copolymer and PVP/eicosene copolymer are used in oil phase of mascara formulations in Cannell and Snyder, respectively, examiner views that the skilled artisan would have had a reasonable expectation of successfully producing a waterproof mascara formulation with similar stability.

### ***Response to Argument***

Applicant's arguments in appeal brief filed on September 4, 2003, have been fully considered but they are not persuasive.

Applicants assert that the rejection cites no motivation or suggest combining the Bartholomey and Snyder references. The motivation to combine the references is based on the objective teaching in Snyder that the PVP tricontanyl polymer is used to make a waterproof mascara composition. While applicants assert that the present invention is effective in "detangling and separating lashes", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, such detangling property would have obviously present in the composition made as motivated by the teaching of the prior arts.

Applicants' assert that the present composition eliminates the need for "setting rate agent" used in Bartholomey. Examiner finds the argument unpersuasive because the prior art setting rate agent composes of the same components which are also present in the instant invention. Bartholomey teaches that the setting rate agent is a mixture of glycerol monostearate and lecithin. See Bartholomey, col. 4, lines 43-44. Applicants require both components in instant claim 1 and claim 9. See also specification pages 23-27.

### ***Conclusion***

No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Gina C. Yu  
Patent Examiner